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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,018	09/01/2001	Craig M. Janik	005532.P007	1644

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Archana B. Vittal
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER

GRIER, LAURA A

ART UNIT

PAPER NUMBER

2644

DATE MAILED: 04/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/945,018

Applicant(s)

JANIK, CRAIG M.

Examiner

Laura A Grier

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-5, 7-9, 11, 13 and 15** are rejected under 35 U.S.C. 102(e) as being anticipated by Janky et al. U. S. Patent No. 6549942.

Regarding **claim 1**, Janky et al. (herein, Janky) discloses an enhanced delivery of audio data for portable playback (figures 1, and 3-4). Janky's disclosure comprises an internetwork server (11) for providing digital audio data via a LAN to a PC (computer), the data is decompressed, there is a D/A converter for converting the digital data into analog electrical data which is transferred to an digital audio playback device (col. 2, lines 1-32 and 42-63 and col. 4, lines 48-51 and col. 9, lines 1-46).

Regarding **claim 2**, Janky discloses everything claimed as applied above (see claim 1). Janky further discloses a user interface (col. 2, lines 52-60).

Regarding **claim 3**, Janky discloses everything claimed as applied above (see claim 1). Janky further discloses the first device as a PC (col. 2, lines 27-32).

Regarding **claim 4**, Janky discloses everything claimed as applied above (see claim 3). Janky further discloses a user interface via a PC (col. 2, lines 27-32 and 52-63)

Regarding **claim 5**, Janky discloses everything claimed as applied above (see claim 3). Janky further discloses the SPU as portable electronic device (abstract and col. 2, lines 1-3, and col. 9, lines 1-21).

Regarding **claim 7**, Janky discloses everything claimed as applied above (see claim 3). Janky further discloses storage of the digital audio data on the computer system on the hard drive, floppy drive, etc, (col. 5, lines 34-44), which constitutes as a database on a computer system.

Regarding **claims 8 and 9**, Janky discloses everything claimed as applied above (see claim 3). Janky further discloses the digital data coming from the Internet, which constitutes as the WAN (col. 4, lines 24-37).

Regarding **claims 11 and 13**, Janky discloses everything claimed as applied above (see claim 3). Janky further discloses wireless transfer of the audio data, thus a wireless transceiver via a wireless transfer protocol is inherently taught, and as well as the portable digital audio playback device inherently the audio converter with a wireless LAN network adapter as evident by the fact that the a Wireless LAN modem may be used (col. 4, lines 48-63 and col. 2, lines 1-8).

3. Regarding **claim 15**, it has been interpreted and thus rejected for the same reasons set forth above in the rejection of **claim 1**. Since **claim 15** discloses a method which corresponds to the apparatus of **claim 1**, the method is inherent in that it simply provides functionality for the logical apparatus implementation found in **claim 1**.

4. **Claims 16-20, 22-24, 26, 28**, are rejected under 35 U.S.C. 102(e) as being anticipated by Janky.

Regarding **claim 16**, Janky et al. (herein, Janky) discloses an enhanced delivery of audio data for portable playback (figures 1, and 3-4). Janky's disclosure inherently supports an audio converter device as evident by the fact that Janky's portable digital audio playback device comprises an internetwork server (11) providing digital audio data via a LAN to a PC (computer), the data is decompressed, a D/A converter for converting the digital data into analog electrical data which is transferred to an digital audio playback device, SPU (col. 2, lines 1-32 and 42-63 and col. 4, lines 48-51 and col. 9, lines 1-46).

Regarding **claims 17, 18 and 19**, Janky discloses everything claimed as applied above (see claim 16). Janky further discloses a user interface via a PC (col. 2, lines 27-32 and 52-63)

Regarding **claim 20**, Janky discloses everything claimed as applied above (see claim 16). Janky further discloses the SPU as portable electronic device (abstract and col. 2, lines 1-3, and col. 9, lines 1-21).

Regarding **claim 22**, Janky discloses everything claimed as applied above (see claim 16). Janky further discloses storage of the digital audio data on the computer system on the hard drive, floppy drive, etc, (col. 5, lines 34-44), which constitutes as a database on a computer system.

Regarding **claims 23 and 24**, Janky discloses everything claimed as applied above (see claim 16). Janky further discloses the digital data coming from the Internet, which constitutes as the WAN (col. 4, lines 24-37).

Regarding **claims 26 and 28**, Janky discloses everything claimed as applied above (see claim 16). Janky further discloses wireless transfer of the audio data, thus a wireless transceiver via a wireless transfer protocol is inherently taught, and as well as the portable digital audio playback device inherently the audio converter with a wireless LAN network adapter as evident by the fact that the a Wireless LAN modem may be used (col. 4, lines 48-63 and col. 2, lines 1-8).

Regarding **claim 32**, Janky discloses everything claimed as applied above (see claim 16). Janky further indicates the communication links as being various means including telephone lines (col. 2, lines 17-32).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 6, 14, 21, 29, and 30-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Janky in view of Adair et al., U. S. Patent No. 6424369.

Regarding **claims 6, 14, 21, and 29**, Janky discloses everything claimed as applied above (see claim 5 13, 16, 20, and 28, respectively). However, Janky fails to specifically disclose the portable electronic device as a personal digital assistant (PDA). The examiner maintains that a PDA was well known in the art.

Regarding the PDA, in a similar field of endeavor, Adair et al. (herein, Adair) discloses hand-held computers incorporating reduced area imaging devices. Adair discloses the use of a PDA for receiving transmitted or transferred audio data/signal from a PC (computer), figures 4 and 5 and col. 6, lines 38-42 and 19, lines 10-12).

Thus it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Janky by providing a PDA, a small portable electronic device, for receiving or download audio.

8. **Claims 10, and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Janky.

Regarding **claims 10 and 25**, Janky discloses everything claimed as applied above (see claim 1 and 16, respectively). Janky discloses that audio transferred to the PC can come for the Internet and as well as other additional data sources (col. 3, lines 61-62).

Thus it would have been obvious to one of the ordinary skill in the art the time the invention was made to modify the invention of Janky by providing a CD player for providing digital audio data to be transmitted to the computer.

9. **Claims 30-31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Janky.

Regarding **claims 30-31**, Janky discloses everything claimed as applied above (see claim 16). Janky discloses the transfer connection of the audio data to the SPU via a hardwire or wireless communication internetwork means (col. 2, lines 4-9). Thus it would have been obvious to one of the ordinary skill in the art the time the invention was made to modify the invention of Janky by incorporating transmission means of a AC power lines and/or Ethernet connection for transferring the audio data to the portable device, wherein such means of audio transmission are commonly used in the art.

10. **Claims 33-38, and 40-41, 43, 45-46, 48-49** are rejected under 35 U.S.C. 103(a) as being unpatentable over Janky in view of Adair.

Regarding **claims 33, 41 and 46** Janky et al. (herein, Janky) discloses an enhanced delivery of audio data for portable playback (figures 1, and 3-4). Janky's disclosure inherently supports an audio converter device as evident by the fact that Janky's portable digital audio playback device comprises an internetwork server (11) for

providing digital audio data via a LAN to a PC (computer), the data is decompressed, there is a D/A converter for converting the digital data into analog electrical data which is transferred to an digital audio playback device, SPU, and a microprocessor (55) for implement automatic transfer of the data via software (col. 2, lines 1-32 and 42-63 and col. 4, lines 48-51 and col. 9, lines 1-46). However, Janky fails to specifically disclose the SPU having a transceiver for receiving the data from the computer. The examiner maintains that use of such a transceiver was well known in the art.

Regarding the transceiver, Adair discloses hand-held computers incorporating reduced area imaging devices. Adair discloses the use of a PDA for receiving transmitted or transferred audio data/signal from a PC (computer), wherein the PDA is a small portable unit (SPU) that includes a transceiver (figures 4 and 5 and col. 6, lines 38-42 and col. 19, lines 10-12, and 26-29).

Thus it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Janky by providing a small portable electronic device, for receiving or downloading audio.

Regarding **claims 34-35, 43-44**, Janky discloses everything claimed as applied above (see claim 33 and 41, respectively). Janky further discloses a user interface via a PC (col. 2, lines 27-32 and 52-63)

Regarding **claim 36**, Janky discloses everything claimed as applied above (see claim 33 and 41, respectively). Janky further discloses the SPU as portable electronic device (abstract and col. 2, lines 1-3, and col. 9, lines 1-21).

Regarding **claims 37-38, 45 and 49**, Janky discloses everything claimed as applied above (see claim 33 and 41, respectively). Adair et al. (herein, Adair) discloses hand-held computers incorporating reduced area imaging devices. Adair discloses the use of a PDA for receiving transmitted or transferred audio data/signal from a PC (computer), figures 4 and 5 and col. 6, lines 38-42 and 19, lines 10-12).

Thus it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Janky by providing a PDA, a small portable electronic device, for receiving or download audio.

Regarding **claims 40 and 48**, Janky discloses everything claimed as applied above (see claim 33 and 41, respectively). Janky further discloses wireless transfer of the audio data, thus a wireless transceiver via a wireless

transfer protocol is inherently taught, and as well as the portable digital audio playback device is inherently the audio converter with a wireless LAN network adapter as evident by the fact that the a Wireless LAN modem may be used (col. 4, lines 48-63 and col. 2, lines 1-8).

11. **Claims 12 and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Janky.

Regarding **claims 12, and 27**, Janky discloses everything claimed as applied above (see claim 1 and 16, respectively). Janky further discloses various wireless transfer protocol may be used. Thus it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Janky by providing the IEEE802.11b protocol for the purpose providing optimal audio data transmission as desired.

12. **Claim 47** is rejected under 35 U.S.C. 103(a) as being unpatentable over Janky in view of Adair.

Regarding **claim 47**, Janky discloses everything claimed as applied above (see claim 41). Janky further discloses various wireless transfer protocol may be used. Thus it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Janky by providing the IEEE802.11b protocol for the purpose providing optimal audio data transmission as desired.

13. **Claims 39 and 42** are rejected under 35 U.S.C. 103(a) as being unpatentable over Janky in view of Adair.

Regarding **claims 39 and 42**, Janky and Adair discloses everything claimed as applied above (see claim 41). However, Janky and Adair fail to specifically disclose a remote control for providing command controls for to a receiver for transfer of the audio data. The use of a remote control is commonly used. Thus it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Janky and Adair by incorporating a remote control outputting command signals to a receiver of the device for the purpose of transmitted audio data as needed for the purpose of providing the user of the device optimal convenience and freedom of movement when using the device.

Art Unit: 2644

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura A Grier whose telephone number is (703) 306-4819. The examiner can normally be reached on Monday - Friday, 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

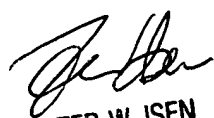
(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

LAG

April 17, 2003


FORESTER W. ISEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600